



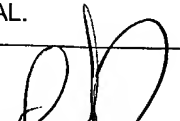
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,338	03/09/2004	Jason M. Cousineau	EMP 0134 PUSP1	1992
22045	7590	08/25/2004	EXAMINER	
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			REIFSNYDER, DAVID A	
			ART UNIT	PAPER NUMBER
			1723	

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/796,338	COUSINEAU ET AL.	
	Examiner	Art Unit	
	David A Reifsnyder	1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/9/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continuing Data

The continuing data in the related-applications section (i.e. page 1, 1st paragraph) of the specification needs to be updated because Application No. 10/131,009 has issued as U.S. Patent No. 6,736,965 B2.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1, 2, 4, 5 and 18-26 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-4, 12, 16-18 and 25-29, respectively of prior U.S. Patent No. 6,736,965 B2. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 3 and 6-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5, 12-18 and 25-29, respectively of U.S. Patent No. 6,736,965 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between claims 3 and 6-17 and claims 5, 12-18 and 25-29, respectively of U.S. Patent No. 6,736,965 B2, is that claims 3 and 6-17 **do not include** a processor while claims 5, 12-18 and 25-29, respectively of U.S. Patent No. 6,736,965 B2 **include** a processor. Since claims 3 and 6-17 are comprising claims, they are broader than claims 5, 12-18 and 25-29, respectively of U.S. Patent No. 6,736,965 B2 and therefore read on claims 5, 12-18 and 25-29, respectively of U.S. Patent No. 6,736,965 B2.

Reasons for Allowance

The main reason for the allowance of claims 1-5 over art is the instantly claimed auxiliary oil filter for a vehicle having an engine lubrication system, the auxiliary oil filter comprising:

a housing having an inlet port for receiving engine oil separately from the engine lubrication system, and an outlet port for returning filtered oil to the engine, the housing

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defining an inlet cavity in fluid communication with the inlet port, and an outlet cavity in fluid communication with the outlet port;

a seal disposed **within** the housing for sealing engine oil substantially within the inlet and outlet cavities;

a media supply reel disposed within the housing and having a roll of filtering media thereon;

a take-up reel disposed within the housing and configured to receive the filtering media from the supply reel; and

a media indexing system disposed **within** the housing and operative to rotate the take-up reel to receive used filtering media.

Regarding claims 1-5; the prior art of record (i.e. Keefer) discloses an oil filter for a vehicle having an engine lubrication system, the oil filter comprising:

a housing (1) having an inlet port (9) for receiving engine oil from the engine lubrication system and an outlet port (30) for returning filtered oil to the engine, the housing defining an inlet cavity in fluid communication with the inlet port, and an outlet cavity in fluid communication with the outlet port;

a gasket seal (8) disposed **around the peripheral of an outside surface** of the housing for sealing engine oil substantially within the inlet and outlet cavities;

a media supply reel (17) disposed within the housing and having a roll of filtering media (19) thereon;

a take-up reel (16) disposed within the housing and configured to receive the filtering media (19) from the supply reel; and

a media indexing system (16', 17', wrenches) disposed **outside** the housing and operative to rotate the take-up reel to receive used filtering media (19) .

Regarding claims 1-5; the prior art of record of record (i.e. Keefer) fails to disclose or fairly suggest that his seal can be disposed within the housing. Furthermore, the prior art of record (i.e. Keefer) also fails to disclose or fairly suggest that his media indexing system can be disposed within the housing.

The main reason for the allowance of claims 6-17 is the instantly claimed oil filtration system for an engine, comprising:

an auxiliary oil filter for receiving and filtering oil from the engine, the auxiliary oil filter including,

a) a housing having an inlet port for receiving engine oil, and an outlet port for returning filtered oil to the engine,

b) a media supply reel disposed within the housing and having a roll of filtering media thereon,

c) a take-up reel disposed within the housing and configured to receive the filtering media from the supply reel, and

d) a media indexing system disposed **within** the housing and operative to rotate the take-up reel to receive used filtering media.

Regarding claims 6-17; the prior art of record (i.e. Keefer) discloses an oil filtration system for an engine, comprising:

an oil filter for receiving and filtering oil from the engine, the oil filter including,

- a) a housing (1) having an inlet port (9) for receiving engine oil, and an outlet port (30) for returning filtered oil to the engine,
- b) a media supply reel (17) disposed within the housing and having a roll of filtering media (19) thereon,
- c) a take-up reel (16) disposed within the housing (1) and configured to receive the filtering media (19) from the supply reel (17), and
- d) a media indexing system (16', 17', wrenches) disposed **outside** the housing and operative to rotate the take-up reel to receive used filtering media.

Regarding claims 12-29; the prior art of record (i.e. Keefer) fails to disclose or fairly suggest that his media indexing system can be disposed within the housing.

The main reason for the allowance of claims 18-26 is the instantly claimed oil filtration system for an engine, comprising:

an auxiliary oil filter for receiving and filtering oil from the engine, the auxiliary oil filter including,

- a) a housing having an inlet port for receiving engine oil, and an outlet port for returning filtered oil to the engine,
- b) a media supply reel disposed within the housing and having a roll of filtering media thereon,
- c) a take-up reel disposed within the housing and configured to receive the filtering media from the supply reel, and

d) a media indexing system disposed **within** the housing and operative to rotate the take-up reel to receive used filtering media; and

a processor for at least controlling the media indexing system and the flow of engine oil into the auxiliary oil filter.

Regarding claims 18-26; the prior art of record (i.e. Keefer) discloses an oil filtration system for an engine, comprising:

an oil filter for receiving and filtering oil from the engine, the oil filter including,

a) a housing (1) having an inlet port (9) for receiving engine oil, and an outlet port (30) for returning filtered oil to the engine,

b) a media supply reel (17) disposed within the housing and having a roll of filtering media (19) thereon,

c) a take-up reel (16) disposed within the housing (1) and configured to receive the filtering media (19) from the supply reel (17), and

d) a media indexing system (16', 17', wrenches) disposed **outside** the housing and operative to rotate the take-up reel to receive used filtering media.

Regarding claims 12-29; the prior art of record (i.e. Keefer) fails to disclose or fairly suggest that his media indexing system can be disposed within the housing. Furthermore, the prior art of record (i.e. Keefer) also fails to disclose or fairly suggest the instantly claimed processor for at least controlling the media indexing system and the flow of engine oil into the auxiliary oil filter.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nozawa et al who discloses an electrostatic oil filter for filtering oil from a diesel engine. Egan et al. who discloses an automotive engine with a multifilter oil lubrication system comprising a full flow oil filter and an auxiliary oil filter.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A Reifsnyder whose telephone number is (571) 271-1145. The examiner can normally be reached on M-F 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda M Walker can be reached on (571) 272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David A Reifsnyder
Primary Examiner
Art Unit 1723

DAR